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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/588,880

05/14/2007

Albrecht Sailer

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10291 7590 08/17/2009  
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EXAMINER

PICKARD, ALISON K

ART UNIT

PAPER NUMBER

3676

MAIL DATE

DELIVERY MODE

08/17/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/588,880	<b>Applicant(s)</b> SAILER ET AL.	
	<b>Examiner</b> Alison K. Pickard	<b>Art Unit</b> 3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 13-16 and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (5,690,342) in view of Applicant's Admitted Prior Art (APA, Spec. paragraph 1).

Tanaka discloses a gasket in Figure 5A having a first layer 1 with a stopper 2/10 around the opening and a bead 9. A second layer 1 has a second bead and a cranking 10 between the stopper and first bead. The cranking is smaller than the bead heights. The layers can be steel but Tanaka does not appear to disclose spring steel. Applicants disclose that it is known to make gasket layers from spring steel. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the layers from spring steel since this is an equivalent material and would yield expected results.

Although it appears the height of the cranking is approximately  $\frac{1}{4}$  the height of stopper 2/10 (i.e. height of plate and shim), Tanaka does not specifically state this. It is not considered inventive to discover the optimum or workable ranges by routine experimentation absent some showing of criticality. See *In re Aller*, 105 USPQ 233, 235 (CCPA 1955). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the cranking and stopper with the claimed range.

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Regarding claim 16, using an additional sheet with a bead is considered a duplication of parts that would yield expected results. See *In re Harza* 124 USPQ 378 (CCPA 1960).

Regarding claim 18, crimping and swaging are process limitations given little patentable weight in a product claim.

3. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka '342 in view of APA as applied to claim 13 above, and further in view of Tanaka (5,639,101).

Tanaka '101 teaches the use of a spacer sheet 4 in a gasket similar to Tanaka '342. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the spacer sheet since the use of a known method to improve a similar device yields expected results.

4. Claims 13-15, 18, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Udagawa (5,058,908) in view of APA.

Udagawa discloses a gasket having a first layer A10 with a stopper A10a around the opening and a bead A10c. A second layer A12 has a second bead A12b and a cranking (between 10b and 12b) between the stopper and first bead. The cranking is smaller than the bead heights. The layers can be steel but Udagawa does not appear to disclose spring steel. Applicants disclose that it is known to make gasket layers from spring steel. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the layers from spring steel since this is an equivalent material and would yield expected results.

Although it appears the height of the cranking is approximately  $\frac{1}{4}$  the height of stopper (i.e. height of plate and shim), Udagawa does not specifically state this. It is not considered inventive to discover the optimum or workable ranges by routine experimentation absent some

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showing of criticality. See *In re Aller*, 105 USPQ 233, 235 (CCPA 1955). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the cranking and stopper with the claimed range.

5. Claims 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (5,639,101).

Tanaka discloses a gasket in Figure 3A, for example, having a first layer 3 with a bead 13. A second layer 1 has a second bead 9 and a cranking 10. And an inner layer 4 has a stopper 2. The cranking is smaller than the bead heights. The layers can be steel but Tanaka does not appear to disclose spring steel. Applicants disclose that it is known to make gasket layers from spring steel. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the layers from spring steel since this is an equivalent material and would yield expected results.

Tanaka does not specifically state the cranking and stopper height meet the claimed range. It is not considered inventive to discover the optimum or workable ranges by routine experimentation absent some showing of criticality. See *In re Aller*, 105 USPQ 233, 235 (CCPA 1955). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the cranking and stopper with the claimed range.

Regarding claim 23, using an additional sheet with a bead is considered a duplication of parts that would yield expected results. See *In re Harza* 124 USPQ 378 (CCPA 1960).

Regarding claim 29, crimping and swaging are process limitations given little patentable weight in a product claim.

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***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 571-272-7062. The examiner can normally be reached on M-F (9-5).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer Gay can be reached on 571-272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alison K. Pickard/  
Primary Examiner, Art Unit 3676

AP